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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,320	07/27/2001	Terry R. Bradfield	1020.P10999	9550
57035	7590	05/24/2007		
KACVINSKY LLC C/O INTELLEVATE P.O. BOX 52050 MINNEAPOLIS, MN 55402			EXAMINER POLLACK, MELVIN H	
			ART UNIT 2145	PAPER NUMBER
			MAIL DATE 05/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/917,320	Applicant(s) BRADFIELD ET AL.	
	Examiner Melvin H. Pollack	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12 March 2007 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.
2. The 101 rejection has been withdrawn, but not for the reasons given by the applicant. While it is true that the invention must provide a useful, concrete, and tangible result, and that the invention as drawn does so, this is not the sole requirement for a statutory category, and an embodiment that fulfills this test may in fact still be non-statutory.
3. To be statutory, 35 USC 101 requires that the subject matter be one of a process, machine, manufacture, composition of matter, or improvements thereof. Software per se and signals per se do not fit any of these categories, but method steps and hardware/software embodiments do fit the categories. The original 101 rejection was based on software-per-se.
4. After further consideration, and after noting that "computer-implemented method" and "computer readable medium" are not further defined, either explicitly and deliberately or via intrinsic evidence, the office has determined that there is insufficient evidence in the specification that it is reasonable to interpret the claims as software-per-se or signals-per-se in light of the context, and that claim 20 does not provide this evidence. This rejection is withdrawn for the reasons above.
5. Regarding the 112 rejections, support for the claims being nearly the entire specification is not the issue. Although the claims are interpreted in light of the specification, limitations from

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the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The meaning of the reading step, and its link to the determining step, is still missing. Why the mobile device reads a port, assuming this is the intended interpretation, is missing. For claim 5, the entity performing the storage is missing. The applicant must clean up the claim language and explain the proper interpretation. Linking steps may be broad, but they cannot be non-existent, and hidden throughout the specification.

6. The applicant has modified the claims by incorporating claims 2, 9, and 16 to claims 1, 5, and 13. The rejection has been modified in light of this fact, but comprises the same art and arguments.

7. In response to applicant's argument that Burton does not disclose two forms of access requirements (P. 14), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Leersen and Burton teach two different forms of access requirements, but in light of their analogous category and of the non-questioned motivation to combine, it is not necessary that either piece of art teach two access requirements.

8. Therefore, the rejection is final.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3-8, 10-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leerssen et al. (7,032,243) in view of Burton et al. (7,130,880).

11. For claim 1, Leerssen teaches a computer-implemented method (abstract; col. 1, line 1 – col. 5, line 10; col. 20, lines 1-25) comprising:

- a. Coupling (col. 5, line 10 – col. 6, line 20) a mobile (col. 6, lines 6 and 14) device (Fig. 1, #10) having a first resource (col. 5, lines 30-35) to a first network environment (Fig. 1, #8);
- b. Reading (col. 8, lines 35-40) a first network identifier (col. 9, lines 25-35) associated with the first network environment and a port by the mobile device (col. 9, lines 35-60);
- c. Determining whether the first network identifier satisfies a first access requirement stored locally at the mobile device by the mobile device (col. 9, line 60 – col. 10, line 65); and
- d. Allowing access to the first resource (col. 9, lines 10-25) if the first network identifier satisfies the first access requirement (col. 10, line 65 – col. 12, line 15).

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12. Leerssen does not expressly disclose that the method of claim 1 further comprises authentication. Burton teaches a method (abstract) for sharing files over a network (col. 1, line 1 – col. 2, line 55; col. 5, lines 5-25), wherein the method further comprises:

- a. Obtaining a user name and password associated with a particular user of the first network (col. 4, lines 35-40);
- b. Reading a second access requirement stored locally at the mobile device (col. 4, lines 1-10); and
- c. Determining if the user name and password satisfies the second access requirement before allowing access to the first resource (col. 4, lines 40-50).

13. At the time the invention was made, one of ordinary skill in the art would have added Burton's authentication Leerssen in order to provide a system for tracking the rights of particular users (col. 1, line 60 – col. 2, line 10).

14. For claim 3, Leerssen does not expressly disclose that the method of claim 1 further comprises authentication. Burton teaches that the method of claim 1 further comprising:

- a. Obtaining a user name and password associated with a particular user of the first network after allowing access to the first resource (col. 4, lines 35-40);
- b. Reading a second access requirement stored locally at the mobile device and associated with a second resource after allowing access to the first resource (col. 4, lines 1-10);
- c. Determining if the user name and password satisfies the second access requirement (col. 4, lines 40-50); and

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- d. Allowing access to the second resource if the user name and password satisfies the second access requirement (col. 4, lines 40-50).
15. At the time the invention was made, one of ordinary skill in the art would have added Burton's authentication Leerssen in order to provide a system for tracking the rights of particular users (col. 1, line 60 – col. 2, line 10).
16. For claim 4, Leerssen teaches the second network environment (Fig. 1, #9), but does not expressly disclose that the method of claim 1 further comprises authentication. Burton teaches that the method of claim 1 further comprising:
- a. Reading a user name and password (col. 4, lines 35-40) associated with a second network environment (Fig. 2);
 - b. Determining whether the user name and password satisfies a second access requirement (col. 4, lines 40-50) stored locally at the mobile device (col. 4, lines 1-10); and
 - c. Allowing access to a second resource associated with the mobile device if the user name and password satisfies the second access requirement (col. 4, lines 40-50).
17. At the time the invention was made, one of ordinary skill in the art would have added Burton's authentication Leerssen in order to provide a system for tracking the rights of particular users (col. 1, line 60 – col. 2, line 10).
18. For claim 5, Leerssen teaches a computer-implemented method (abstract) of establishing and using sharing criteria to control access to a resource (col. 1, line 1 – col. 5, line 10; col. 20, lines 1-25) comprising:

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- a. Reading (col. 8, lines 35-40) a first network identifier (col. 9, lines 25-35) associated with a first network environment (Fig. 1, #8) and a port by a mobile device (col. 9, lines 35-60);
 - b. Receiving, by the mobile device, an indication that a first resource on the mobile device is to be associated with the first network identifier (col. 9, lines 35-60); and
 - c. Storing the first network identifier in a first association with a resource identifier that identifies the first resource so that access to the resource is contingent upon receipt of the first network identifier (col. 10, lines 10-50).
19. Leerssen does not expressly disclose that the method further comprises authentication. Burton teaches that the method further comprising:
 - a. Receiving a user name and password associated with a particular user (col. 4, lines 35-40);
 - b. Receiving an indication that the first resource is to be associated also with the user name and password (Fig. 3); and
 - c. Storing the user name and password in a second association with the resource identifier so that the access to the first resource is contingent also upon receipt of the user name and password (col. 3, lines 35-50).
20. At the time the invention was made, one of ordinary skill in the art would have added Burton's authentication Leerssen in order to provide a system for tracking the rights of particular users (col. 1, line 60 – col. 2, line 10).

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21. For claim 6, Leerssen teaches the storing of the first network identifier in association with the resource identifier is accomplished by copying a portion of an association between the first network identifier and a second resource (col. 11, lines 5-15).
22. For claim 7, Leerssen teaches that the method of claim 5 further comprising:
 - a. Receiving a network identifier associated with an entity attempting to access the resource (col. 9, lines 25-35);
 - b. Comparing the received network identifier with the stored network identifier (col. 11, lines 50-60); and
 - c. Allowing access to the first resource if the received network identifier matches the stored network identifier (col. 12, line 60 – col. 13, line 35).
23. For claim 8, Leerssen teaches the method of claim 5 further comprising:
 - a. Receiving a network identifier associated with an entity attempting to access the resource (col. 9, lines 25-35);
 - b. Comparing the received network identifier with the stored network identifier (col. 11, lines 50-60); and
 - c. Denying access to the first resource if the received network identifier does not match the stored network identifier (col. 12, line 60 – col. 13, line 35).
24. For claim 10, Leerssen teaches removing the first association between the first network identifier and the resource identifier so that access to the first resource is allowed without receipt of the first network identifier (Fig. 7A).

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25. For claim 11, Leerssen teaches suspending temporarily the first association between the first network identifier and the resource identifier so that access to the first resource is allowed without receipt of the first network identifier (Fig. 5A, #119).

26. For claim 12, Leerssen teaches the method of claim 5 further comprising:

- a. Displaying a second network identifier (col. 9, lines 35-60);
- b. Receiving an indication that the first resource is to be associated with the second network identifier (col. 9, lines 25-35); and
- c. Storing the second network identifier in a second association with the resource identifier so that access to the first resource is contingent upon receipt of either the first network identifier or the second network identifier (col. 10, lines 10-50).

27. For claim 13, Leerssen teaches a computer readable medium (abstract) including instructions for causing a processor (col. 1, line 1 – col. 5, line 10; col. 20, lines 1-25) to:

- a. Read (col. 8, lines 35-40), by a mobile (col. 6, lines 6 and 14) device (Fig. 1, #10), a first network identifier (col. 9, lines 25-35) associated with a first network environment and a port (col. 9, lines 35-60);
- b. Receive, by the mobile device, an indication that a first resource on the mobile device is to be associated with the first network identifier (col. 9, lines 35-60); and
- c. Store in memory the first network identifier in a first association with a resource identifier that identifies the resource so that access to the first resource is contingent upon receipt of the first network identifier (col. 10, lines 10-50).

28. Leerssen does not expressly disclose that the method further comprises authentication.

Burton teaches the computer readable medium wherein the instructions cause the processor to:

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- a. Receive a user name and password associated with a particular user (col. 4, lines 35-40);
 - b. Receive an indication that the first resource is to be associated also with the user name and password (Fig. 3); and
 - c. Store in the memory the user name and password in a second association with the resource identifier so that the access of the first resource is contingent also upon receipt of the user name and password (col. 3, lines 35-50).
29. At the time the invention was made, one of ordinary skill in the art would have added Burton's authentication Leerssen in order to provide a system for tracking the rights of particular users (col. 1, line 60 – col. 2, line 10).
30. For claim 14, Leerssen teaches in which to store in the memory the first network identifier in association with the resource identifier a copy of a portion of an association between the first network identifier and a second resource is used (col. 11, lines 5-15).
31. For claim 15, Leerssen teaches in which the computer readable medium of claim 13 wherein the instructions cause the processor to:
 - a. Receive a third network identifier (col. 9, lines 35-60);
 - b. Compare the third network identifier with the stored first network identifier (col. 11, lines 50-60); and
 - c. Allow access to the resource if the third network identifier and the stored first network identifier are substantially equal (col. 12, line 60 – col. 13, line 35).

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32. For claim 17, Leerssen teaches wherein the instructions cause the processor to remove the first association between the first network identifier and the resource identifier so that access to the first resource is allowed without receipt of the first network identifier (Fig. 7A).

33. For claim 18, Leerssen teaches wherein the instructions cause the processor to suspend temporarily the first association between the first network identifier and the resource identifier so that access to the first resource is allowed without receipt of the first network identifier (Fig. 5A, #119).

34. For claim 19, Leerssen teaches wherein the processor is located in a mobile device comprising one of the following: a notebook computer, a mobile telephone and a personal digital assistant (col. 6, lines 5-7).

35. For claim 20, wherein the resource comprises one of the following: a folder, a directory, a file, an application, a printer, a disk drive, a ROM drive, memory and a scanner (col. 6, lines 35-55).

Claim Rejections - 35 USC § 112

36. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

37. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: usage of the first network identifier and a port, and functional link to the first access requirement.

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38. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: in regards to step b, whether the mobile device performs the reading step, the associating step, or both.

Conclusion

39. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melvin H Pollack
Examiner
Art Unit 2145

MHP
22 May 2007

A handwritten signature in black ink, appearing to read "Mel H Pollack", is written in a cursive style.